UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/131,915	08/10/98	KANIA	B 3295-0025-0-

022850 QM12/1214
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

EXAMINER	
PREBILIC,P	
ART UNIT	**PAPER NUMBER**
3738	14

DATE MAILED: 12/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/131,915	Argoblast et al
Examiner	**Group Art Unit**
Paul Prebilic	3738

☒ Responsive to communication(s) filed on *Sep 29, 2000*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *22-47, 52, and 53* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) *40-43, 45, and 47* is/are allowed.

☒ Claim(s) *22-28, 44, 46, 52, and 53* is/are rejected.

☒ Claim(s) *29-39* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *10*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Specification

The abstract of the disclosure is objected to because it is still too concise and fails to adequately describe the invention. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 29, 2000 have been approved.

Inventorship

In view of the papers filed September 29, 2000, the inventorship in this nonprovisional application has been changed by the deletion of Robert E. Arbogast, James W. Capper, James Covin, and Jeffery L. Doddroe.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-25 and 52-53 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen (US 5,633,286). Chen anticipates the claim language wherein the splint, slings or weight belts are inherently open ended tubular devices because they are designed to fit around cylindrical parts of the body; see the whole document.

Alternatively, if one interprets the disclosure of splints, slings, or weight belts as not disclosing tubular open ended devices as claimed because they are not explicitly set forth in this manner, the Examiner posits that the disclosure of such elements makes a tubular open ended device clearly obvious because the body parts to be covered are cylindrical.

With regard to claim 24, it is noted that ceramics and glass have lower elasticity (almost zero) compared to foam or gel; see column 4, lines 45-65.

With regard to claim 52 specifically, the Examiner posits that the Chen device has some Shore OO durometer value although unmeasured. Therefore, the Examiner hereby asserts that the durometer value of Chen is within the claimed range and hereby burdens Applicant to show otherwise.

Claims 26-28 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 5,633,286) in view of Lerman (US 4,832,010). Chen at least obviates the claim language as set forth above but fails to clearly set forth fabric coverings of coatings over the gel thereof. Lerman, however, teaches that it was known to the art to cover of coat similar foams of gels with fabric in order to protect the foams or gels and keep such materials from contacting the skin. Hence, it is the Examiner's position that it would have been obvious to coat the gels of foams of Chen with fabric for these same reasons.

With regard to claim 44 specifically, Lerman discloses the use of his device over a joint to function as an orthotic device. Hence, it is the Examiner's position that it would have been obvious to form the Chen device into a joint supporting orthotic device as disclosed so that it could be used to treat the joint in a more rigid fashion over the use of a mere foam; see the abstract of Chen.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen and Lerman as applied to claim 44 above, and further in view of Caprio, Jr. et al (US 5,656,023). Chen at least obviates the claim language as set forth in the earlier rejection but fails to disclose support bars. Caprio, Jr. et al teaches that it was known to use support bars in similar devices within the art; see elements (52) thereof. Hence, it is the Examiner's position that it would have been obvious to include support bars in the Chen devices for the same reasons that Caprio, Jr. et al does the same and in order to improve the supporting function of the Chen devices.

Allowable Subject Matter

Claims 40-43 and 45 are allowed over the prior art of record.

Claims 29-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in

MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned problem is corrected.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

Paul Prebilic
Primary Examiner
Art Unit 3738

ATTACHMENT TO AND MODIFICATION OF NOTICE OF ALLOWABILITY (PTO-37)

(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored[1]:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

---

[1] The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "*Changes to Implement the Patent Business Goals*", 65 *Fed. Reg.* 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 99, 110, 135, 139 (September 19, 2000).